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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/684,173	10/06/2000	James R. Kittrell	00-625	3692

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Gregory P. LaPointe
Bachman & LaPointe, P.C.
900 Chapel Street, Suite 1201
New Haven, CT 06510-2802

EXAMINER

TRAN, THAO T

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 04/04/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/684,173

Applicant(s)

KITTRELL, JAMES B.

Examiner

Thao T. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27 and 28 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 27 and 28 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This is in response to the Request for Consideration received on January 31, 2003. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.
2. Claims 27-28 are currently pending in this application.

Claim Rejections - 35 USC 102/§ 103

3. Claims 27-28 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kramer et al. (US Pat. 6,086,749).

Kramer teaches a catalyst composite, comprising a combination of silica, titania, tungsten oxide, and platinum (see col. 37, ln. 2-20). Kramer further teaches tungsten oxide (Group VIB metal) to be about 0.5 to about 50% by weight; platinum (Group VIII metal) about 0.1 to about 10% by weight; and that the total metal components would be about 0.1 to about 60% by weight of the total catalyst (see col. 37, ln. 32-51), overlapping the instantly claimed ranges. Thus, the total weight of silica and titania would inherently be about 40 to about 99.1%, overlapping the instantly claimed ranges.

Although Kramer is silent with respect to the weight percent of silica and titania separately, the weight percent of silica and titania each would be inherently overlapping the instantly claimed ranges, because the silica weight is presently claimed to be about 0.1% to about 70% whereas the titania weight about 30% to about 90%.

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Therefore, the subject matter as a whole would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have selected the overlapping portion as taught by Kramer, because overlapping ranges have been held to be a *prima facie* case of obviousness. See *MPEP 2144.05*.

4. Claims 27-28 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hamner et al. (US Pat. 3,887,455).

Upon further consideration, the rejection of claims 27-28 over Hamner has been withdrawn in view of the prior Office Action of October 09, 2003.

5. Claims 27-28 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over O'Hara (US Pat. 3,640,817).

O'Hara teaches a catalyst composite, comprising a mixture of metallic components from Groups VIB and VIII, such as tungsten and platinum, combined with a porous carrier material containing a mixture of silica and titania (see col. 2, ln. 44-59). O'Hara further teaches the porous carrier material containing about 10.0% to about 90.0% weight of silica (see col. 2, ln. 63-66); the catalyst composite containing about 4.0% to about 30.0% of tungsten and about 1.0% to about 10.0% of platinum (Group VIII) (see col. 3, ln. 35-44).

Thus, the amount of silica and titania would inherently be about 60 to about 96%, in which there are about 10.0 to about 90.0% weight of silica and about 10.0 to about 90.0% weight of titania, which reads upon the instantly claimed ranges of silica and titania.

With respect to the platinum component, O'Hara teaches the catalyst comprising about 1 to about 10% of platinum (see col. 5, ln. 46-47), overlapping the instantly claimed range.

Therefore, the subject matter as a whole would have been obvious to one of ordinary skill in the

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art, at the time the invention was made, to have selected the overlapping portion as taught by O'Hara, because overlapping ranges have been held to be a *prima facie* case of obviousness. See *MPEP 2144.05*.

Response to Arguments

6. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicant alleges that the examiner has reached the conclusion using hindsight reconstruction based on Applicant's own disclosure, whereas the prior art does not teach or suggest the combination of elements in the specific weight percentages claimed in claim 27.

However, the references of Kramer and O'Hara, each teach a catalyst composition comprising the same constituents as recited in the presently claimed invention. And as pointed out in this and the prior Office Action, both references teach the composition with the weight percent of each constituent overlapping the instantly claimed range.

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Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thao T. Tran whose telephone number is 703-306-5698. The examiner can normally be reached on Monday-Friday, from 8:30 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 703-308-2462. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

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March 27, 2003



James J. Seidleck
Supervisory Patent Examiner
Technology Center 1700